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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK WEEDMARK and PIERO SORRINI

Appeal 2009-006529
Application 10/724,711¹
Technology Center 2400

Decided: April 14, 2010

Before JAMES D. THOMAS, JAY P. LUCAS, and STEPHEN C. SIU,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 8 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

¹ Application filed December 2, 2003. The real party in interest is Alcatel.

We affirm.

Appellants' invention relates to a method of efficiently tracing failures of active connection modify (ACM) requests in a connection-oriented communication network (Spec. ¶ [009]). In the words of Appellants:

Associated with a connection are particular traffic parameters like bandwidth and service categories. These traffic parameters are normally setup for the duration of the call, however, there are user applications when the traffic parameters associated with a connection needs to be modified without being service affecting. For instance, a user browsing the Internet may want to temporarily increase his bandwidth to watch a video or download a large file from the Internet.

(Spec. ¶ [002].)

Once [a] destination node receives [an ACM] request, it will allocate any additional resource requirements and send a Modify Acknowledgement back to [a] source node. . . . [E]ach node that receives this message will allocate its resources that were reserved, from the Modify Request message, and allow the transmission of data at the new rate. . . .

. . . [T]he ACM may fail at one of the nodes along the connection being modified.

(Spec. ¶¶ [004] and [005].)

The method of the present invention provides the ability to immediately identify the node at which the ACM failure occurred and provides more detailed vendor specific information on the cause of the failure.

(Spec. ¶ [0012].)

Claim 1 is exemplary, and is reproduced below:

1. A method for of [sic] an active connection modify in a connection oriented communication network, comprising the steps of:

appending a trace transit list information element (TTL IE) to a modify request message;

transmitting said modify request message from a source node to a destination node along said active connection; and

at each node along said active connection, modifying a parameter of said active connection while recording in said TTL IE failure identification data.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Karia	US 6,643,267	Nov. 04, 2003
		(filed on Jun. 30, 1999)

ITU-T, "Series Q: Switching and Signaling Broadband ISDN – B-ISDN application protocols for access signaling, Digital Subscriber Signaling System No. 2 – connection modification: peak cell rate modification by the connection owner," Q.2963.1 (December 1999) (hereinafter referred to as "ITU-T Q2963.1").

REJECTION

The Examiner rejects the claims as follows:

Claims 1 to 8 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Karia.

Appellants contend that the claimed subject matter is not anticipated by Karia because “the Office Action has excessively and improperly relied on allegations of inherency” (*see* Brief 5, middle) and because the claim limitation “modifying a parameter of said active connection” (claim 1) is not inherently taught by Karia (Brief 6, middle). The Examiner contends that each of the claims is properly rejected (Ans. 14, top).

The claims are grouped as per Appellants’ Brief. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

The issues involve whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e). The first issue specifically turns on whether Karia’s “request message” is a teaching for Appellants’ claimed “a modify request message” (claim 1). The second issue is whether “modifying a parameter of said active connection,” as recited in claim 1, is taught by Karia.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method of tracing an active connection modify (ACM) request message through the nodes of a communication network. (*See* claim 1.) The method includes, at each node along the active connection, modifying a parameter of said active connection while recording failure identification data in the transit list information element (TTL IE) (*id.*).

Karia

2. The Karia reference teaches a method of tracing a request message through the nodes of a communication network (col. 2, ll. 8-10). Karia's method includes, at each node along the active connection, modifying a parameter of said active connection while recording failure identification data in the transit list information element (TTL IE). (*See* col. 2, ll. 29-32; col. 3, ll. 40-43.)

ITU-T Q2963.1

3. The ITU-T Q2963.1 reference teaches that a connection modification is defined as "the alteration of the characteristics of an established connection with regard to the connection's traffic parameters" (Section 3.2). Further, when a request to modify a connection is rejected, ITU-T Q2963.1 teaches incorporating the cause for the rejection in the modify reject message content (Table 8-3).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

"[L]imitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Our reviewing court states in *In re Zletz* that "claims must be interpreted as broadly as their terms reasonably allow" (*id.*).

Our reviewing court has determined that extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter. *In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991). *See also* MPEP § 2131.01(II.).

ANALYSIS

From our review of the administrative record, we find that the Examiner presents his conclusions of unpatentability on pages 3 to 6 of the Examiner's Answer. In opposition, Appellants present numerous arguments.

*Arguments with respect to the rejection
of claims 1 to 8
under 35 U.S.C. § 102(e)*

Appellants argue: “[T]he Office Action has excessively and improperly relied on allegations of inherency in putting forth the rejection.” (Brief 5, middle).

The Examiner finds that Karia teaches the claimed “modify request message” in columns 1 and 2 and Figures 1 and 2 (Ans. 3, middle). The Examiner finds that, among other things, Appellants’ claimed “modify request message” reads on an Operation, Administration, and Maintenance (OAM) message. (*See* col. 1, ll. 49-52 and 56-57; Ans. 3, top.) The Examiner does, however, rely upon ITU-T Q2963.1 for a definition of “modify,” as claimed (*id.*), invoking the doctrine of inherency.

We carefully considered Appellants’ Brief, the Examiner’s Answer, the cited portions of Karia and ITU-T Q2963.1, and indeed the entire references. In this case, we agree with the Examiner’s conclusions of unpatentability for the following reasons.

First, regarding Karia’s teachings, we find that Appellants have invented a method of tracing an active connection modify (ACM) request message through the nodes of a communication network (FF#1). The method includes, at each node along the active connection, modifying a parameter of said active connection while recording failure identification data in the transit list information element (TTL IE) (*id.*). In comparison, the Karia reference teaches a method of tracing a request message (Appellants’ claimed “active connection modify”) through the nodes of a communication network (FF#2). Karia’s method includes, at each node

along the active connection, modifying a parameter of said active connection while recording failure identification data in the transit list information element (Appellants' claimed "trace transit list information element") (*id.*).

The Examiner finds that Appellants' claim limitation "a modify request message" reads on Karia's "request message" (col. 1, l. 64; Ans. 3, middle). Here, we note that Appellants chose not to explicitly define an ACM request in either their Specification or exemplary claim 1. Instead, Appellants merely offered examples in the Specification of an ACM request (*i.e.*, "changing the bandwidth of a connection"). (*See* ¶ [0018].) However, this Board will not read any limitations from the Specification into the claims. (*See In re Van Geuns*, cited above.) Reading the claim language broadly but reasonably, *see In re Zletz*, cited above, we find that Appellants' claimed "a modify request message" reads on Karia's "request messages."

Second, regarding the Examiner's use of inherency, our reviewing court has determined that extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter. *In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991). *See also* MPEP § 2131.01(II).

We find that the ITU-T Q2963.1 reference defines a connection modification (Appellants' claimed "modify request message") as a message requesting "the alteration of the characteristics of an established connection with regard to the connection's traffic parameters" (FF#3). When a "modify request message" is rejected (Appellants' claimed "failure"), ITU-T Q2963.1 teaches incorporating the cause (Appellants' claimed "failure identification data") for the rejection in the content of a modify reject message (*id.*). We decline to say that the Examiner's reliance upon a second

reference (*i.e.*, ITU-T Q2963.1) merely to define the claim term “modify” is an improper use of the cited reference. (*See Baxter Travenol Labs.*, cited above.) In accordance with the teachings of *Baxter Travenol Labs.*, cited above, we find that a person of ordinary skill in the art would have recognized Karia’s teachings for a “request message” as inherently including a “modify request message,” as recited in claim 1, for purposes of modifying “an active connection.”

In conclusion, in light of the broadest reasonable interpretation of the claimed “modify request message” (claim 1) and the definition of modification in ITU-T Q2963.1 (*see* FF#3), we find unconvincing Appellants’ argument that the Examiner has “excessively and improperly relied on allegations of inherency.” Accordingly, we find no error.

Next, Appellants’ argue: “[The] step of modifying a parameter [claim 1] ... is not inherently disclosed in Karia. . . . Specifically, ‘the use of ATM networks which by definition incorporate the reservation of resources in conjunction with a Modify Request message’ [the Examiner’s words] in no way describes ‘modifying a parameter’ [claim 1].” (Brief 6, middle).

In reply, the Examiner finds that Karia inherently teaches “modifying a parameter of said active connection,” as recited in exemplary claim 1 (Ans. 3, middle).

Where Appellants’ claim recites “at each node along said active connection, modifying a parameter of said active connection,” the claim term “of” may be interpreted as “at each node along said active connection, modifying a parameter ‘associated with’ said active connection.”

Recognizing that the TTL IE travels the same path as the active connection, a person of ordinary skill in the art would have also understood

a parameter “associated with” said active connection as including any Trace Transit List (TTL) Information Element (IE) parameter that changes at each node along the active connection. Here, we note that the Karia patent says: “Each node traversed by the message (including the source node) adds one entry to the TTL IE.” (Col. 2, ll. 29-31). Since “of said active connection,” as claimed, may be interpreted as “associated with said active connection,” Appellants’ claim limitation “at each node along said active connection, modifying a parameter of said active connection” reads on Karia’s teachings for adding one entry to the TTL IE at each node traversed by the message (*id.*). For all of the above-stated reasons, Appellants’ claim limitation “modifying a parameter of said active connection” (claim 1) is met by our claim interpretation and Karia’s teachings. Accordingly, we find no error.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 8.

DECISION

The Examiner’s rejection of claims 1 to 8 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2009-006529
Application 10/724,711

peb

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